

### REMARKS

Reconsideration of the Office Action mailed November 23, 2004, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 16-26 and 36-38, and are respectfully requested.

In the instant Office Action, claims 16-26 and 36-38 are listed as pending and claims 16-26 and 36-38 are listed as rejected.

Applicants gratefully acknowledge that the Examiner has withdrawn the rejections of claims 16 and 36 under 35 U.S.C. §102(b) and 35 U.S.C. §103(a).

The Examiner has rejected claims 16-26 and 36-38 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states "[i]n claim 16, it has been recited a proviso to exclude 54 compounds, but there is no descriptive support for this proviso." Without conceding to the correctness of the Applicants have cancelled claim 16 without waiver or prejudice to Applicants right to prosecute said claim in a continuation or divisional application. Applicants have amended claim 18 to incorporate the structural formula and its description from claim 16. Based upon the limitations of claim 18 as originally written and the deletion of "pyrazole" from the definition of R, amended claim 18 does not encompass the reference compounds previously cited against Applicants under 35 U.S.C. §102(b). Claim 20 was amended to conform with the scope of claim 18 as currently amended. Applicants have cancelled Claim 21 without waiver or prejudice. Claim 22 was amended to change its dependency from claim 21 to claim 20 after cancellation of Claim 21.

Based upon the foregoing, the rejection of claims 16-26 and 36-38 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement is obviated and should be withdrawn.

The Examiner has rejected claims 16 and 36 under 35 U.S.C. §103(a) as allegedly being unpatentable over Otsuka et al. (JP 61229874). The Examiner states:

[c]ited reference discloses a compound of interest: 2,-[(4-methoxyphenyl)methylene-4-methyl-2H-1,4-benzothiazin-3(4H)-one that is useful for the vasodilator diltiazem. Said compound is almost the same as the excluded compound: 2,-[(4-methoxyphenyl)methylene-2H-1,4-benzothiazin-3(4H)-one when applicant's compound has the following substituents: n=0, R=phenyl (aromatic) substituted by methoxy, Q = C, R = H, and X = oxygen.

Applicants respectfully traverse this rejection. As discussed above in reply to the rejection of claims 16-26 and 36-38 under 35 U.S.C. §112, first paragraph, Applicants have cancelled claim 16 and amended claim 18. Otsuka et al. does not teach or suggest Applicants' genus as currently amended in claim 18, which limits R to substituted or unsubstituted indole, pyrrole, 7-azaindole, imidazole and indazole. In order for an invention to be considered obvious under 35 U.S.C. 103(a), the invention must be considered as a whole, there must be some motivation or suggestion in the prior art reference itself to modify the reference, and there must be a reasonable expectation of success.

The Court of Appeals for the Federal Circuit has stated the following on the issue of obviousness:

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F. 2d 1044, 1051-52, 5 USPQ 1434, 1438 (Fed. Cir. 1988), cert. denied, 109 S. Ct. 75 (1988), on remand, 13 USPQ2d 1192 (D. Conn. 1989) "Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."; In re Stencel, 828 F. 2d 751,755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made." Alco Standard Corp. v. Tennessee Valley Authority, 808 F. 2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986), cert. dismissed, 108 S. Ct. 26 (1987) "the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability, and thus the obviousness, of making the combination.'"; Carella v. Starlight Archery, 804 F. 2d 135,231 USPQ 644 (Fed. Cir. 1986); ACS Hospital Sys., Inc. v. Montefiore Hospital, 732 F. 2d 1572, 221 USPQ 929 (Fed. Cir. 1984) "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

Donald S. Chisum, Patents, A Treatise on the Law of Patentability, Validity and Infringement, Vol. 2, 5-218, 1992.

Applicants point out that the Court of Appeals, Federal Circuit stated in In re Grabiak that "there must be adequate support in the prior art for the ester/thioester change in structure, in order to complete the PTO's prima facie case and shift the burden of going forward to the applicant." In re Grabiak, 226 USPQ 870, 872, 1985.

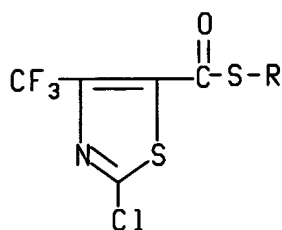
The Grabiak court further cited the following passage from In re Bergel, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961), in support of their ruling:

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contain something to suggest the desirability of the proposed combination.

In re Grabiak, 226 USPQ 870, 872.

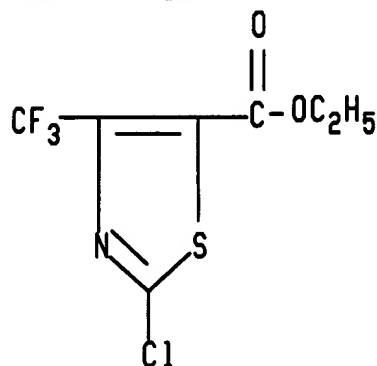
The Grabiak court made the above statement in light of the fact that both appellant's compounds and the prior art compounds were very similar in structure (see below) and had the same utility, namely, as herbicidal safeners.

Grabiak's Compound:



wherein R is C<sub>1-5</sub>alkyl, phenyl or benzyl

Howe's Compound:



Note that when the R substituent is ethyl in the Grabiak compound, that the only difference in structure between Grabiak and Howe is a single atom, namely, an oxygen atom versus a sulfur atom. Hence, structural similarity and identical utility on its own cannot be the sole basis for a rejection under 35 U.S.C. § 103. Yet, the Examiner's rejection in the instant application under 35 U.S.C. § 103 does just that. The rejection is based solely upon structural and use similarity between the instant application and Altmann without any suggestion from said reference, which

is in direct contravention to well-established decisions of the Court of Appeals for the Federal Circuit.

Based upon the foregoing, the rejection of claims 16 and 36 under 35 U.S.C. §103(a) over Otsuka et al. is obviated and should be withdrawn.

The Examiner has rejected claims 16-26 and 36-38 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection. Responses to the Examiner's enumerated points are set out below in accordance with the instant Office Action.

a. In claim 16, the phrase " $R^2$  is...a substituent" is indefinite. The Examiner asks "What substituent? What is covered and what is not?" Applicants have cancelled claim 16 but the phrase cited by the Examiner now appears in amended claim 18. Without conceding to the correctness of the Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, Applicants have added "as defined below" following " $R^2$  is...a substituent" and Applicants have incorporated the definition of substituents from page 18, line 16 to page 19, line 28 of the specification into the end of claim 18.

b. In claim 16, the phrase "Suitable substituents" is indefinite. Applicants have cancelled claim 16 but have amended claim 18 to incorporate much of original claim 16. Without conceding to the correctness of the Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, Applicants have deleted the phrase "suitable substituents" and incorporated the definition of substituents from page 18, line 16 to page 19, line 28 of the specification into the end of claim 18.

c. The Examiner has maintained the rejection of claims 16-26 and 36 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the phrases "substituted with suitable substituents", "substituted or unsubstituted" are unclear as to the nature and number of substituents intended. Without conceding to the correctness of the Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to

place it in condition for allowance, Applicants have cancelled claims 16 and 17 and Applicants have amended claim 18 to delete the phrase "suitable substituents" and include the definition of substituents as found on page 18, line 16 to page 19, line 28 of the specification into the end of claim 18.

d. The Examiner states that "[i]n claim 16 (page 5, one line from the bottom), the second chemical structure does not fall within the scope of claim 16". This rejection is moot in view of Applicants' cancellation of claim 16.

e. The Examiner states that the terms "aliphatic" or "aromatic" in claim 16 or elsewhere in the claims are not clear. Applicants have cancelled claims 16 and 17. Without conceding to the correctness of the Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, in amended claim 18, Applicants have incorporated the definitions of "aliphatic" and "aromatic" at the end of claim 18. Support for this amendment can be found, *inter alia*, at page 11, lines 3-5 and page 11, lines 7-22.

f. The Examiner states that "[i]n claim 16 (page 2)), the phrase "when X is O and n is 0, R<sup>1</sup> is hydrogen" is not clear....The parenthesis includes both N-R<sup>1</sup>, thus if n=0, R<sup>1</sup> can't be hydrogen." Applicants have cancelled claim 16 but in amended claim 18, Applicants have amended the formula so that the parenthesis are shorter for R<sup>1</sup> to be hydrogen when n = 0. Support for this amendment can be found, *inter alia*, page 16, line 20 of the application as originally filed. Applicants note, however, that in the application as filed "n" was inadvertently omitted from the formula.

g. The Examiner states "[i]n claim 16, the compounds that are excluded and the definition of the variables R and R<sup>1</sup> is not clear." This rejection is moot in view of Applicants' cancellation of claim 16.

Based upon the foregoing, the rejection of claims 16-26 and 36-38 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is obviated and should be withdrawn.

Based upon the foregoing, Applicants believe that claims 18, 20, 22-26 and 36-38 are in condition for allowance. Prompt and favorable action is earnestly solicited.

No fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

Date: April 12, 2005

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